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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/978,637	11/25/1997	ELAZAR RABBANI	ENZ-53(DIV5)	4643

28170 7590 12/03/2002

ENZO DIAGNOSTICS, INC.  
C/O ENZO BIOCHEM INC.  
527 MADISON AVENUE 9TH FLOOR  
NEW YORK, NY 10022

EXAMINER

SCHMIDT, MARY M

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**08/978,637**

Applicant(s)  
**Rabbani et al.**

Examiner  
**Mary Schmidt**

Art Unit  
**1635**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 245-280, 282-284, and 286-316 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 245-280, 282-284, and 286-316 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov 25, 1997 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2002, has been entered.

#### ***Drawings***

2. The drawings dated 11-25-97 have been reviewed by an Official draftsman and a copy of the PTO-948 is attached.

#### ***Election/Restriction***

3. This application contains claims directed to the following patentably distinct species of the claimed invention: (1) claim 246: eukaryotic or prokaryotic; (2) claims 247, 278, 302: nucleic acid or nucleic acid construct or nucleic acid conjugate, virus or viral fragment or viral vector, viroid, phage, plasmid, plasmid vector, bacterium or, bacterial fragment or a specific combination; (3) claim 248: single-stranded, double-stranded or partially double-stranded; (4) claims 249-250, 303: DNA, RNA, nucleic acid analogs, or a specific combination; (5) claims 251, 268, 279: DNA, RNA, DNA-RNA hybrid, DNA-RNA chimera, or a specific combination; (6) claim 253: promoter, initiator, terminator, intron, cellular localization element, or a specific combination, (7) claim 254: signal processing element is located in the primary nucleic acid component, secondary nucleic acid component, nucleic acid product, tertiary nucleic acid

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component, or a specific combination; (8) claims 256, 273, 312: antisense RNA, antisense DNA, ribozyme, protein binding nucleic acid sequence, or a specific combination; (9) claim 257: viral assembly or viral replication; (10) claim 259: viral vector, phage vector, plasmid vector, or a specific combination thereof; (11) claim 261: eukaryotic or prokaryotic; (12) claim 267: cytoplasmic or nuclear localization signaling sequence; (13) claims 271, 296: U1, U2, or both; (14) claims 275, 276, 277, 292, 293, 294, 304: RNA or DNA; (15) claim 283: viral vector, phage vector, plasmid vector or a specific combination; (16) claim 289: organism, organ, tissue, culture, or a specific combination; (17) claim 300: part of the same polynucleotide sequence or part of different polynucleotide sequences; (18) claim 305: more than one promoter, more than one initiator, both; (19) claim 306: different promoters, different initiators or both; (20) claim 307: complementary to a viral RNA, complementary to a cellular RNA, bind to a viral protein, bind to a cellular protein, or a specific combination; (21) claim 309: viral protein comprises localizing protein, viral protein comprises decoy protein, cellular protein comprises localizing protein, cellular protein comprises decoy protein; (22) claim 310 nuclear or cytoplasmic; (23) claim 311: viral assembly or viral replication.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, for each group, (1)-(23), the claims not included in the group are generic. For each claim listed in each group, applicant may elect a unique choice. However, one choice must be made for all claims recited above to be responsive.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

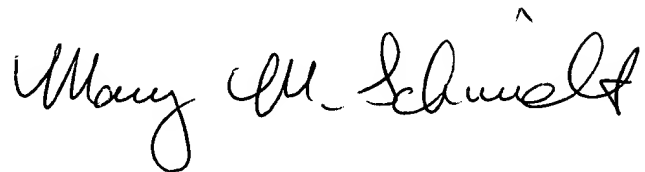
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader*, may be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to *Katrina Turner*, whose telephone number is (703) 305-3413.

A handwritten signature in cursive script that reads "Mary M. Schmidt". The signature is written in dark ink and is positioned in the lower right area of the page.

M. M. Schmidt  
December 2, 2002